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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,959	03/06/2002	Min-Hsun Hsieh	KYCP0003USA	7583

27765 7590 12/18/2002

NAIPO (NORTH AMERICA INTERNATIONAL PATENT OFFICE)
P.O. BOX 506
MERRIFIELD, VA 22116

EXAMINER

DANG, PHUC T

ART UNIT	PAPER NUMBER
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2818

DATE MAILED: 12/18/2002

Remail
4-12-04

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/683,959

Applicant(s)

HSIEH ET AL.

Examiner

PHUC T DANG

Art Unit

2818

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Group I, Claims 1-6, drawn to a method for manufacturing a light emitting diode having a transparent substrate, classified in class 438, subclass 22.
- II. Group II, Claims 7-14, drawn to an apparatus of a light emitting diode having a transparent substrate, classified in class 257, subclass 79.

The inventions are distinct, each from the other because of the following reasons:

1. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be practiced by another materially different apparatus or by hand (2) that the apparatus as claimed can be used to practice another and materially different process (MPEP § 806.05(e)). In the instant case unpatentability of the Group II invention would not necessarily imply unpatentability of the Group I invention, since the device of Group II invention could be made by a product different from those of the Group I invention such as the step of etching the first substrate from the third multiplayer structure instead of removing.

However, the issues of process and apparatus claims are divergent. Furthermore, there may be some overlap in the searches of the two groups, but there is no reason to believe that the searches would be identical. Therefore, based on the additional work involved in searching and examination of the two inventions together, restriction of distinct inventions is clearly proper.

2. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traverse (37 CFR 1.143).
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).
4. Any inquiry concerning this communication or earlier communication from the examiner should be direct to Phuc T. Dang whose telephone number (703) 305-1080. The examiner can normally be reached on Monday through Friday from 8:00am to

5:00pm.

Phuc T. Dang PP
Examiner
Art Unit 2818

PHUC T. DANG
EXAMINER



August 19, 2002